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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,755	01/19/2005	Satoru Takahashi	264464US0PCT	7217
22850 7590 01/02/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER BROWN, COURTNEY A	
			ART UNIT 1616	PAPER NUMBER
			NOTIFICATION DATE 01/02/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

**Application No.**

10/521,755

**Applicant(s)**

TAKAHASHI ET AL.

**Examiner**

Courtney A. Brown

**Art Unit**

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/19/2005 and 6/10/2005</u> .                                 | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Priority***

Priority to International Patent Application Number PCT/JPO3/10073 filed on August 7, 2003 is acknowledged.

### ***Information Disclosure Statement***

Receipt of Information Disclosure Statements filed on January 19, 2005 and June 1, 2005 is acknowledged.

### ***Status of the Claims/Response to Restriction.***

Applicant's claims are drawn toward herbicide compositions.

Applicant elected claims 1 and 4-22 without traverse. Claims 2 and 3 are withdrawn from further consideration. Applicant also provisionally elected, without traverse, compound of formula (I) wherein  $R^1$  and  $R^2$  are methyl groups,  $R^3$ - $R^6$  are hydrogen,  $n$  is 2,  $R^{28}$  is a methyl group,  $R^{29}$  is a  $-CF_3$  group, and  $R^{30}$  is a  $-OCHF_2$  group. Claims 1 and 4-22 filed on January 19, 2005 are currently pending examination for patentability.

### ***Objections to the Oath***

The oath of this application was not executed in accordance with either 37 CFR 1.66 or 1.68 because it is not written in English.

***Double Patenting***

Claim 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 2-11 of co-pending U.S. Application No. 11/948542. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to the same art recognized subject matter. A reference anticipating one set of claim will render the other obvious and it would have been obvious to one of ordinary skill in the art at the time of the invention was made since U.S. Application No. 11/948542 teach a herbicidal composition comprising compounds of Formula I and a second compound (component C). Claims 1-20 of the present application is directed to herbicide containing compounds of Formula I, as an active ingredient along with the same compounds as taught in U.S. Application No. 11/948542. One of ordinary skill in the art would have been motivated by Application No. "542 to make herbicides of similar compositions. In looking at the instantly claimed composition as a whole, the claimed composition would have been suggested to one skilled in the art unless unobvious or unexpected results can be shown. Therefore, claims 1-20 are rejected.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21 and 22 recites the limitation "The herbicidal composition according to claim 1, wherein ii) at least one compound of Group A in lines 1 and 2 in claim 21 and lines 3 and 4 in claim 22. There is insufficient antecedent basis for this limitation in the claim because in claim 1, the term, "Group A", was removed in a preliminary amendment filed on 1/19/2005.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

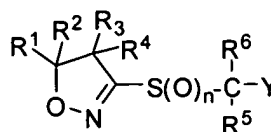
the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 and 4-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoneda et al.. (JP 09-328483) in view of Sievernich et al., (US 6,534,444 B1).

### ***Applicant's Invention***

Applicant claims an herbicidal composition which comprises i) an isoxazoline derivative represent by formula (I) and ii) at least one compound selected from the group consisting of atrazine, simazine, cyanazine, isoxaflutole, mesotrione, flumetsulam, imazethapyr, imazapyr, dicamba, clopyralid, prosulfuron, halosulfuron-methyl, rimsulfuron, bentazone, carfentrazone-ethyl, metribuzin, thifensulfuron-methyl, nicosulfuron, primisulfuron, cloransulam-methyl, glufosinate, glyphosate, glyphosate-trimesium, pendimethalin, linuron, prometryn, diflufenican, flumioxazin, and metolachlor wherein at least one compound of ii) is comprised in an amount of from 0.001 to 100

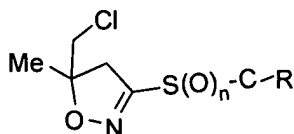
parts by weight to 1 part by weight of i) an isoxazoline derivative represented by formula (I) and ii) is in a total amount of from 0.5 to 90%.



**Formula (I)**

***Determination of the scope and the content of the prior art  
(MPEP 2141.01)***

Yoneda et al. teach herbicidically active 2-isoxazoline derivatives of the formula below:



wherein R represents a heterocyclic group (See pages 3-9).

***Ascertainment of the difference between the prior art and the claims  
(MPEP 2141.02)***

Yoneda et al. do not teach the alkyl group in position R<sup>1</sup> being unsubstituted (specifically the Cl substituent in the prior art) as in the present application.

Additionally, JP 9-328483 does not teach the use of at least one compound selected from the group consisting of atrazine, simazine, cyanazine, isoxaflutole,

mesotrione, flumetsulam, imazethapyr, imazapyr, dicamba, clopyralid, prosulfuron, halosulfuron-methyl, rimsulfuron, bentazone, carfentrazone-ethyl, metribuzin, thifensulfuron-methyl, nicosulfuron, primisulfuron, cloransulam-methyl, glufosinate, glyphosate, glyphosate-trimesium, pendimethalin, linuron, prometryn, diflufenican, flumioxazin, and metolachlor.

Sievernich et al disclose a synergistic herbicidal mixture using the components such as atrazine, cyanazine (photosynthesis inhibitors) (column 6, lines 50-51), and glyphosate (an enolpyruvylshikimate-3-phosphate synthase inhibitor) (column 3, lines 41-43) as in the instant application. Additionally, Sievernich et al. disclose he mixtures comprising a 3-heterocyclyl-substituted benzoyl derivative and a herbicidal compound from the Group B7 (enolpyruvylshikimate-3-phosphate synthase inhibitors (ESPS)), preferably glyphosate or sulfosate, in a weight ratio of 1:1.4 to 1:216, preferably 1:2.4 to 1:43.2 (see column 27, lines 65-67 to column 28, lines 1-2) and photosynthesis inhibitors mixtures that comprise a 3-heterocyclyl-substituted benzoyl derivative and a herbicidal compound from group B12 (photosynthesis inhibitors) in a weight ratio of 1:0.12 to 1:800, preferably 1:0.2 to 1:160 (see column 29, lines 26-30).

***Finding of prima facie obviousness***

***Rationale and Motivation (MPEP 2142-2143)***



It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to combine the teachings of Yoneda et al. and Sievernich et al. to produce a herbicidal composition. The idea of combining them flows logically from their having been individually taught in prior art, thus claims that requires no more than mixing together two or three conventional herbicides set forth prima facie obvious subject matter. It is known in the art that combining herbicides increase the efficacy of a herbicide such that the maximum level of control or growth regulation for a given application rate of a herbicide is increased, or alternatively, the application rate of a herbicide giving optimum control or growth regulation can be reduced. Additionally, one skilled in the art would expect that the instant claims which are analog to Yoneda et al., prima facie. A person skilled in the art could be have easily replaced some of the substituent groups of the isoxazoline derivatives (for example H for C1) for presenting equivalent herbicidally active compounds. Furthermore, the specification of the present application does not describe at all the compounds of Formula I, in the claims of the present application exhibit an excellent herbicidal effect compared with compounds of Yoneda et al. Therefore, The motivation to make claimed 2-isoxazoline derivatives with methyl halogen substituent in the alkyl group derives from the expectation that structurally similar compounds generally expected to have similar properties and have similar utilities. Thus, in view of *In re Kerkhoven*, 205 USPQ 1069 (C.C.P.A. 1980), it is prima facie obvious to combine two or more compositions, each of which is taught by prior art to be useful for the same purpose, in order to form a third composition that is to

be used for the very same purpose.

None of the claims are allowed.

### ***Conclusion***

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR Only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Courtney Brown, whose telephone number is 571-270-3284. The examiner can normally be reached on Monday-Friday from 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:  
10/521,755  
Art Unit: 1616



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